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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,253	06/07/2000	Kerimcan Engin	3212/3	8672

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**'Office Action Summary**

Application No.

09/589,253

Applicant(s)

ENGIN ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Original claims 1-20 have been examined. The rejections are stated below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ray et al (US Patent 6018722).

With reference to claim 1, Ray teaches a system for providing financial investment advice, comprising: a strategy having at least one trade recommendation; a portfolio for defining holdings of an investor based on the at least one trade recommendation; and a strategy client database for permitting the investor to access the at least one trade recommendation of the strategy (See Ray Claim 1).

With reference to claim 2, Ray teaches a system of claim 1, further comprising a risk management utility for allowing the investor to conduct one or more risk analyses on the strategy (See Ray Column 7 lines 22-29).

With reference to claim 3, Ray teaches a system of claim 1, wherein the portfolio includes means for weighting the strategy (See Ray Column 7 line 65 – Column 8 line 2).

With reference to claim 4, Ray teaches a system of claim 1, further comprising a network permitting an advisor to submit the strategy to the exchange (See Ray Column 10 lines 55-64).

With reference to claim 5, Ray teaches a system of claim 1, further comprising steps of initiating transactions and communicating with the operating program (See Ray Column 4 lines 30-36). The operating program is interpreted to include a search utility for selecting the strategy.

With reference to claim 6, Ray teaches a system of claim 1, further comprising a network allowing investors to access the system (See Ray Column 9 lines 44-60).

With reference to claim 7, Ray teaches a system of claim 6, wherein the network provides a communication link to a brokerage account of the investor (See Ray Column 10 lines 13-16).

With reference to claim 8, Ray teaches a system of claim 1, further comprising at least one brokerage account for executing trades based on the holdings of the investor and the at least one trade recommendation (See Ray Column 9 line 65 – Column 10 line 16).

With reference to claim 9, Ray teaches a system of claim 1, further comprising means for distributing the at least one trade recommendation to the portfolio at predetermined intervals (See Ray Column 9 lines 1-8). Once daily is interpreted to include predetermined intervals.

With reference to claim 10, Ray teaches a system of claim 1, further comprising using electronic updates from sources such as Schwablink (See Ray Column 7 lines 49-56). Electronic

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information from sources such as Schwablink is interpreted to include a market data source for providing real-time financial instrument prices.

With reference to claim 11, Ray teaches a system comprising: means for providing a plurality of advisor strategies for financial investment (See Ray Claims 2 – 4); means for subscribing to at least one of the advisor strategies (See Ray Column 9 lines 29-43 and Column 10 lines 55-64); means for selectively customizing the at least one of the advisor strategies into an investor portfolio (See Ray Claim 1); and means for generating a plurality of trade recommendations based on the investor portfolio (See Ray Claim 5).

With reference to claim 12, Ray teaches a system of claim 11, wherein the at least one of the advisory strategies includes investment preferences and other information (See Ray Column 5 lines 1-29) Investment preferences and other information are interpreted to include at least one parameter selected from the group consisting of an initial investment amount, a recommended minimum investment, a tradable financial instrument set allowed position types, and restrictions on cash transactions.

With reference to claim 13, Ray teaches a system of claim 11, further comprising means for executing a plurality of trade transactions based on the trade recommendations (See Ray Claim 1 and Column 10 lines 13-16).

With reference to claim 14, Ray teaches a system of claim 11, further comprising means for updating the advisor strategies at predetermined intervals (See Ray Column 9 lines 1-8). Once daily is interpreted to include predetermined intervals.

With reference to claim 15, Ray teaches a method of providing investment advice to at least one investor, comprising: providing at least one advisor strategy accessible by way of a

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computer network (See Ray Column 9 lines 44-61; using a strategy client database to maintain a subscription to the at least one advisor strategy for the at least one investor (See Ray Column 9 lines 29-43 and Column 10 lines 55-65); and maintaining a portfolio for the at least one investor, the portfolio defining a plurality of trade recommendations and being based on the at least one advisor strategy (See Ray Claim 1).

With reference to claim 16, Ray teaches a method of claim 15, further comprising providing the plurality of trade recommendations to a brokerage account (See Ray Column 9 line 65 – Column 10 line 16).

With reference to claim 17, Ray teaches a method of claim 16, further comprising providing the plurality of trade recommendations to a brokerage account (See Ray Column 10 lines 13-16).

With reference to claim 18, Ray teaches a method of claim 15, further comprising translating a plurality of strategy trade recommendations into the trade recommendations defined by the portfolio (See Ray Claim 5).

With reference to claim 19, Ray teaches a method of claim 18, further comprising updating the strategy trade recommendations at predetermined intervals (See Ray Column 9 lines 1-8). Once daily is interpreted to include predetermined intervals.

With reference to claim 20, Ray teaches a method of claim 15, further comprising synchronizing information contained in the portfolio with a brokerage account (See Ray Claim 9).

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***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Cwenar (US Patent 5893079) (April 6, 1999) System for Receiving, Processing, Creating, Storing, and Disseminating Investment Information

(b) O'Shaughnessy (US Patent 6317726 B1) (November 13, 2001) Automated Strategies for Investment Management

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
October 24, 2002

